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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/662,940 | 09/16/2003 | Kimball C. Chen | 64171.000002 | 2033 |
| 21967 | 7590 | 07/31/2007 | EXAMINER | |
| HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109 | | | BORISOV, IGOR N | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3628 | | |
| | | MAIL DATE | | DELIVERY MODE |
| | | 07/31/2007 | | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/662,940 | CHEN ET AL. | |
| | Examiner | Art Unit | |
| | Igor N. Borissov | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 April 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-432 is/are pending in the application.
- 4a) Of the above claim(s) 6,9-12,14,16,18,20-151,153-179,183-185,188-191,193,195,197,199-330 and 332-432 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,7,8,13,15,17,19,152,180-182,186,187,192,194,196,198 and 331 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/25/2007 has been entered.

Response to Amendment

Amendment received on 04/25/2007 is acknowledged and entered. Claims 1-432 are pending in the application. Claims 4-6, 9-12, 14, 16, 18, 20-151, 153-179, 183-185, 188-191, 193, 195, 197, 199-330, and 332-432 are withdrawn from consideration. Claims 1, 2, and 181 have been amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7, 8, 13, 15, 17, 19, 152, 180-182, 186, 187, 192, 194, 196, 198 and 331 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr. et al. (US 5,544,036) in view of Woolard et al. (US 6,178,362).

Brown, Jr. et al. (Brown) teaches a method and system for remote energy management and home automation system, said system including a central

computer 24, a communication device (controller 14), and a communication link (transmitter 20), said method comprising:

Claims 1 and 180,

generating at least one informational message at a central computer related to one or more of resource-consumption by, resource-production by and control of at least one device (C. 4, L. 7-14; Figs. 1,2);

transmitting the at least one informational message to at least one communication device (controller 14) (C. 4, L. 7-14),

where the at least one communication device (controller 14) initiates at least one action having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device of one or more devices (C. 4, L. 7-18).

Brown does not explicitly teach that said central computer includes a server. However, the use of a computer as a server is old and well known. For example, Woolard et al. (Woolard) teaches a method and system for remote energy management and home automation system, said system including a central server 60 (Fig. 3), which is configured to be in control communication with peripheral energy consuming devices D (C. 7, L. 37-38, 8-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Brown to include that said central computer includes a server, as disclosed in Woolard, because it would advantageously allow to implement said system for multi-building facility, and interconnect various equipment for purposes of control and managing, as specifically stated in Woolard (C. 7, L. 32-35).

Claims 2 and 181, Brown teaches said method and system, wherein the at least one informational message comprises at least one control signal and wherein the at least one communication device comprises at least one interface unit, where the interface unit in communication with the one or more devices controls the at least one device in accordance with the at least one control

signal, to take an action having the effect of providing a change of one or more of resource-consumption and resource-production attributed to the at least one device (C. 4, L. 7-18).

Claims 3 and 182, Woolard teaches: receiving at least one command at the central server, wherein the at least one command is related to controlling at least one device and wherein the at least one informational message is generated based on the at least one command (C. 5, L. 47-51). The motivation to combine references would be to provide tools for developing strategies to reduce energy costs (Woolard; C. 5, L. 49).

Claims 7 and 186, Brown teaches said method and system, wherein the at least one informational message comprises an instruction directed to one or more of activating and deactivating the at least one device (C. 4, L. 7-14).

Claims 8 and 187, Brown teaches said method and system, wherein the at least one informational message comprises an instruction to adjust the operation of the at least one device wherein the instruction to adjust the operation is directed to one or more of state, use, one or more parameters, one or more set points, operating characteristics, duty cycle, control logic and scheduling of the at least one device (C. 4, L. 44-51).

Claims 13, 14, 152 and 192, 194, 331, Woolard teaches said method and system, wherein the at least one command is generated in accordance with a user profile (C. 6, L. 49-54).

Claims 17 and 196, Brown teaches said method and system, wherein the devices comprises one or more of an air-conditioner, boiler, motor starter and heater (C. 4, L. 63-66).

Claims 19 and 198, Brown teaches said method and system, wherein the interface unit causes the adjustments of one or more of resource-consumption and resource-production attributed to the at least one device in accordance with the at least one informational message (C. 4, L. 10-19, 47).

Response to Arguments

Applicant's arguments filed 04/25/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are related to a method and system for remote energy management and home automation system, said system including a central computer. The motivation to modify Brown to include that said central computer includes a server, as disclosed in Woolard, would be implementing said system for multi-building facility, and interconnecting various equipment for purposes of control and managing, as specifically stated in Woolard (C. 7, L. 32-35).

Furthermore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the applicant's argument that the prior art fails to disclose "receiving at least one command at the central server, wherein the at least one command is related to controlling at least one device and wherein the at least one informational message is generated based on the at least one command", it is noted that Woolard teaches said feature (C. 5, L. 47-51).

In response to the applicant's argument that the prior art fails to disclose that "the at least one command is generated in accordance with a user profile", it is noted that Woolard was applied to disclose said feature (C. 6, L. 49-54).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

7/25/2007



IGOR N. BORISSOV
PRIMARY EXAMINER